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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/575,260

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EXAMINER

SULLIVAN, DANIELLE D

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/575,260	Applicant(s) TSUCHIKAWA ET AL.	
	Examiner DANIELLE SULLIVAN	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/05/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-17 are pending examination.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 10/501,401 in view of Yoneyama et al. (US 5,362,482). Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application does not contain 39.9 to 89.9% ester oil.

The instant application claims a composition comprising an ester compound (0.1-10%, preferably 0.4-2%); ester oil (39.9-89.9%, preferably 57.1-74.8%) and ultraviolet protective powder (10-50%, preferably 24.8-39.9%). The composition may further comprise hydrogenated lecithins.

Copending application '401 discloses a composition comprising ester compound (0.1-30), ester oil (0.5-20%) and a surfactant (0.1-40%). Surfactants include hydrogenated lecithin's [0035]. Example containing ultraviolet protective powders such as titanium dioxide (12%) are disclosed (Example 12; [0049]).

Copending application '401 does not teach that the range of the ester oil is 39.9-89.9%, preferably 57.1-74.8% or the preferred range of ultraviolet protective powder is 24.8-39.9%. It is for this reason that Yoneyama et al. is joined.

Yoneyama et al. teaches cosmetic compositions containing an oil component and a powder (abstract). The composition comprises 5% to 85% by weight of oil (column 3, lines 47-50). The oils may be selected from glycerol tri-2-ethylhexanoate

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and pentaerythritol tetra-2-ethylhexanoate (ester oils) (column 5, lines 41-60). The powder comprises 5-50% by weight as conventionally used in cosmetic compositions and include titanium oxide and zinc oxide (column 6, lines 21-44).

One would have been motivated to manipulate ranges during routine experimentation to discover the optimum or workable range since Yoneyama et al. provides the general ranges. Therefore, one would have been motivated to use the appropriate amount of ester oil and ultraviolet protective powder necessary to achieve the cosmetic product disclosed in the present claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Applicant's arguments filed 2/05/2009 have been fully considered but they are not persuasive. Applicants argue that the claims of the present application do not contain water-soluble inorganic salt. Applicants further argue that the ultraviolet protective powder is not a constituent in the claims of the '401 application.

First, it should be noted that the present claims use comprising language. Therefore, the presence of a water-soluble inorganic salt in '401 still renders the present claims obvious. Furthermore, although the claims do not recite the presence of ultraviolet protective powders, the disclosure of '401 envisages the use of ultraviolet protective powders, such as titanium dioxide in the compositions ([0050] and Example 12). Therefore, in view of Yoneyama the claims in '401 may further include ultraviolet protective powders if desired.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoneyama et al. (US 5,362,482) in view of Suzuki (US 6,759,052).

Applicant's Invention

Applicant claims a preparation comprising 0.1-10% by weight an ester compound, 39.9-89.9% by weight of an ester oil and 10 to 50% by weight of an ultraviolet protective powder. Claim 2 specifies the preparation comprises the ester compound 0.4-2%, ester oil 57.1-74.8% ultraviolet protective powder 24.8-39.9%. Claims 3 and 4 specify the ester compound is glycerin behenate eicosanedioate (Nomcort HK-G). Claim 5 specifies the ester oil has a viscosity of 4-100 mPa*s at 20°C. Claim 6 and 7 further limits to the ester compound being selected from neopentyl glycol dicaprate, glyceryl tri-2-ethylhexanoate and pentaerythritol tetra-2-ethylhexanoate. Claim 8 specifies the u/v protective powder is selected from titanium dioxide, iron-containing titanium dioxide and zinc oxide. Claim 14 specifies that the preparation is a cosmetic. Claim 15 further limits the cosmetic to being selected from lotions, creams, ointments, foundations, lipsticks, mascaras, eyeshadows, eyebrows, nail enamels and cheek colors. Claim 16 specifically lists the preparation as comprising 0.1-10% ester compound, 39.9-89.9%

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ester oil and 10-50% ultraviolet protective powder, wherein the limitations of claims 7 and 8 are added.

Determination of the scope and the content of the prior art

(MPEP 2141.01)

Yoneyama et al. teaches cosmetic compositions containing an oil component and hydrophobically treated powder (abstract). The composition comprises 5% to 85% by weight of oil (column 3, lines 47-50). The oils may be selected from glycerol tri-2-ethylhexanoate and pentaerythritol tetra-2-ethylhexanoate (column 5, lines 41-60). The powder comprises 5-50% by weight as conventionally used in cosmetic compositions and include titanium oxide and zinc oxide (column 6, lines 21-44).

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

Yoneyama et al. does not teach the specific ester compound. It is for this reason that Suzuki is added.

Suzuki teaches cosmetic compositions comprising ester compounds as an emulsifier, glycerin fatty acid surfactant (column 6, lines 34-39). The cosmetic compositions comprising Nomcort HK-G (3%) and isotridecyl isononate (0.2%) in the form of a cream (Example 46). The amount of ester compound can range from 0.1-10% and provides a light feel, stability and fluidity when applied on the skin (column 7, lines 22-25).

Finding of prima facie obviousness

Rationale and Motivation (MPEP 2142-2143)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Yoneyama and Suzuki to use the ester compound in the cosmetic compositions. One would have been motivated to include glycerin fatty acid surfactants such as glyceryl behenate eicosanedioate because Suzuki teaches that it is used in cosmetic compositions to provide a light feel, stability and fluidity to cosmetic compositions.

Claims 9-11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoneyama et al. (US 5,362,482) in view of Suzuki (US 6,759,052) and in further view of Miyoshi et al. (US 5,968,531).

Applicant's Invention

Applicant claims a preparation as discussed in above 103(a) rejection. Claims 9 and 17 further adds lecithin to the composition. Claim 10 specifies the ratio of lecithin to the total composition is 0.0001:1 to 0.05:1. Claim 11 specifies that the lecithin is hydrogenated.

Determination of the scope and the content of the prior art

(MPEP 2141.01)

Yoneyama et al. and Suzuki teach the composition as discussed in above 103(a) rejection. Suzuki also teaches that the cosmetic composition comprise powders including coated mica. To improve dispersability or adhesion, the powders can be surface treated by metallic soaps.

**Ascertainment of the difference between the prior art and the claims
(MPEP 2141.02)**

Yoneyama et al. and Suzuki do not teach that lecithin is added. It is for this reason that Miyoshi et al. is joined.

Miyoshi et al. teaches that hydrogenated lecithin is a surface treating composition used, to impart desired characteristics to composite powders in conjunction with metallic soap (column 3, line 62-67). The agents aid in a desired aesthetic feel, pressability and improved transparency on the skin (column 4, lines 4-7). An example of a compressed powder foundation comprising 7% hydrogenated lecithin treated mica is disclosed (Example 3).

**Finding of prima facie obviousness
Rationale and Motivation (MPEP 2142-2143)**

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Yoneyama, Suzuki and Miyoshi et al. to further include hydrogenated lecithin in the cosmetic compositions. One would have been motivated to include lecithin because Miyoshi teaches that adding hydrogenated lecithin to composite powders improve their aesthetic feel and transparency on the skin.

Response to Arguments

Applicant's arguments filed 2/05/2009 have been fully considered but they are not persuasive. Applicants argue that Yoneyama does not disclose, teach or suggest every element necessary to establish a prima facie case of obviousness because

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Yoneyama does not disclose the ultraviolet protective preparation of the present invention. Applicants further argue that Yoneyama does not disclose that pentaerythritol tetra-2-ethylhexanoate alone can be used in an amount of 5-85%.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The Examiner disagrees with Applicants viewpoint. First, Yoneyama teaches incorporating the ultraviolet protective components titanium oxide and zinc oxide in the amounts of 5-50% as a powder (column 6, lines 21-34). Second, Yoneyama teaches that the second embodiment of the present invention, **in addition to the above-mentioned silicone oil, other oils can be formulated** into the composition including pentaerythritol tetra-2-ethylhexanoate (column 5, lines 41-55). Yoneyama teaches that 5-80% by weight of the total cosmetic is the total oil (column 5, lines 33-35). Therefore, the amount of pentaerythritol tetra-2-ethylhexanoate can range from 5-80% by weight of the total cosmetic. Hence, Yoneyama teaches the addition of an ultraviolet protective preparation and that pentaerythritol tetra-2-ethylhexanoate alone can be used in an amount of 5-85%.

Applicants further argue that Suzuki does not disclose an ultraviolet protective preparation. Example 31 taught by Suzuki discloses a preparation comprising titanium dioxide. Furthermore, Suzuki teaches that titanium dioxide and other UV shuttering

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agents may be used in the formulations (column 5, line 50 through column 6, line 15).

Hence, the combination of Yoneyama and Suzuki render the present claims obvious.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Danielle Sullivan whose telephone number is (571) 270-3285. The examiner can normally be reached on 7:30 AM - 5:00 PM Mon-Thur EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Danielle Sullivan
Patent Examiner
Art Unit 1616

/Johann R. Richter/

Supervisory Patent Examiner, Art Unit 1616